

A 1/3714
ST



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mark L. Yoseloff, et al. Examiner: C. White
Serial No. 09/654,025 Group Art Unit: 3714
Filed: September 1, 2000 Docket No. PA0463.ap.US
Title: VIDEO GAMING SYSTEM WITH WILD CARD SYSTEM AND
BONUS SYSTEM

MAIL STOP APPEAL BRIEF-PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED
JUN 18 2003
TECHNOLOGY CENTER R3700

The following documents are hereby submitted:

- ☒ Appeal Brief to the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office (three copies)
- ☒ Authorization to withdraw \$320.00 to cover Appeal Brief Fee
- ☒ Petition for Request for 1-month Extension of Time
- ☒ Transmittal Sheet
- ☒ Return postcard

Please consider this a PETITION FOR EXTENSION OF TIME for sufficient number of months to enter these papers if an additional extension of time is deemed necessary by the Office. Authorization is hereby given to charge Deposit Account Number 50-1391 if such additional extension is necessary.

MARK A. LITMAN & ASSOCIATES, P.A.
York Business Center, Suite 205, 3209 W. 76th St.
Edina, MN 55435 (952-832-9090)

By: Mark A. Litman
Atty: Mark A. Litman
Reg. No. 26,390

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on June 11, 2003.

Mark A. Litman
Nam

Signature

06/16/2003 TL0011 00000004 501391 09654025
Sale Ref 00080007 DAB 501391 09654025
01 FC:1408 320.00 DA
02 FC:1451 110.00 DA



(1)

S/N 09/654,025

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Mark L. Yoseloff et al.	Examiner:	C. White	#13
Serial No.:	09/654,025	Group Art Unit:	3714	
Filed:	September 1, 2000	Docket:	PA0463.ap.US	6/19/03
Title:	VIDEO GAMING SYSTEM WITH WILD CARD SYSTEM AND BONUS SYSTEM			

3 loss

APPEAL BRIEF TO THE BOARD OF
PATENT APPEALS AND INTERFERENCES OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

MAIL STOP BOX APPEAL BRIEF - PATENTS
Commissioner for Patents and Trademarks
P.O. BOX 1450
Alexandria, VA 22313-1450

RECEIVED
JUN 18 2003
TECHNOLOGY CENTER R3700

Sir:

This is an appeal from the Office Action mailed on December 31, 2002, finally rejecting claims 1-10 and 12-21. All other claims are objected to because they depend from a rejected claim.

This Brief is being filed in triplicate along with authorization to debit \$320.00 to Deposit Account No. 50-1391 to cover the fee for the appeal. Appellants request the opportunity for a personal appearance before the Board of Appeals to argue the issues of this appeal. The fee for the personal appearance will be timely paid upon receipt of the Examiner's Answer.

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 11, 2003.

Mark A. Litman
Name

Signature

06/16/2003 TLWU11 00000007 501391 09654025

01 FC:1402 320.00 DA

TABLE OF CONTENTS

Page No.

Real Party in Interest.....	3
Status of Claims.....	4
Status of Amendments.....	5
Summary of the Invention.....	6
Issues.....	7
Related Appeals and Interferences	8
Grouping of Claims.....	9
Arguments of Appellant.....	10-16
Conclusion.....	17
Appendix.....	18-22

REAL PARTY IN INTEREST

The real party in interest is the assignee, Shuffle Master, Inc. a corporation promulgated under the Laws of the State of Minnesota and having a principal place of business at 1106 Palms Airport Drive, Las Vegas, Nevada 89119-3730.

STATUS OF CLAIMS

Claims 1-10 and 12-21 stand finally rejected under 35 U.S.C. 103(a) as unpatentable over Bennett (US Patent No. 6,251,013) in view of Schultz (US Patent No. 5,332,228).

Claim 11 now stands as objected to and will be allowed when placed into independent form.

No other claims appear in the Application.

STATUS OF AMENDMENTS

An Amendment After Final Rejection was filed on March 28, 2003. The amendments were accepted, but were deemed to not place the Application in condition for allowance. No rejections under 35 USC 112 remain in the Application and no objection for the presence of New Matter exists in the Application.

SUMMARY OF THE INVENTION

Wagering games (e.g., roulette, craps, slots, video poker, table card games, and gaming machines or computers using gaming software), including those intended primarily for play in casinos, should provide players with a sense of participation and control, the opportunity to make decisions, and reasonable odds of winning, even though the odds favor the casino, house, dealer or banker. The game must also meet the requirements of regulatory agencies.

Wagering games, including wagering games for casino play, with multiple wagering opportunities are known. Additional symbols may be added to the usual means of playing a game to increase wagering opportunities. (Page 1, lines 12-26).

The invention enables a method of playing a video wagering game with a bonus feature. The bonus feature occurs when a player places a wager on a reel-slot-type video game having a plurality of symbol positions. The reel-slot-type game displays a plurality of randomly selected game symbols on a display, each symbol appearing in a designated symbol position. The game addresses any winning events by a procedure selected from the group consisting of

- a) resolving any winning events,
- b) carrying any winning events forward for later resolving, and
- c) carrying any winning events forward for modification of the winning event by a bonus play.

Upon the occurrence of a predetermined triggering event for a bonus event, the game randomly selects at least one and fewer than all of the plurality of symbol positions as a wild symbol position. The game then converts each symbol displayed within each selected wild symbol position to a wild symbol. After the symbol has been converted, the game determines a bonus outcome based on the displayed game symbols and wild symbols within the gaming event. (Page 11, lines 5-17 and original claim 15).

ISSUES ON APPEAL

The sole generic issue that remains in this Appeal is whether the subject matter as a whole has been shown to be obvious from the combined teachings of Bennett in view of Schultz in accordance with the requirements of 35 U.S.C. 103(a).

More specific issues in this Appeal consider whether:

- 1) If a reference fails to teach an element in the claim for which it is cited and that element is not shown by the other reference in the rejection, can an erroneous rejection for obviousness be sustained by the Board of Patent Appeals and Interferences?
- 2) If references cannot be combined because of diverse teachings in the reference, can the mere asserted existence of the words making up the limitations in claims on appeal sustain a rejection in compliance with 35 U.S.C. 103(a)?

RELATED APPEALS AND INTERFERENCES

Appellants do not know of any other pending U.S. Patent Applications that are on appeal which have issues that overlap with the issues in this Appeal. No Interference proceedings before the U.S. Patent and Trademark Office are known by Appellants to have any substantive relationship to the subject matter of this Appeal.

GROUPING OF CLAIMS

The following grouping of claims is made in compliance with the requirements of 37 C.F.R. 1.191 for the content of an Appeal Brief. The following grouping of claims is made to expedite this Appeal and narrow issues, and is not intended to waive or limit the right of the Applicants to enforce and defend claims separately, even though they are grouped for convenience in this Appeal.

Under the Single Ground of Rejection on This Appeal

The rejection of claims 1-8, 10 and 13-15 and 17-21 shall stand or fall with the patentability of claim 1.

The rejection of claim 9 shall stand or fall alone. This claim defines a specific visual relationship between the symbol to which a position is converted and the appearance of the original symbol.

The rejection of claim 12 shall stand or fall by itself. This claim recites that game outcomes are determined based upon the predetermined combinations of displayed game symbols and wild symbols.

The rejection of claim 16 shall stand or fall by itself. This recites specific alternative payout characteristic order.

ARGUMENTS OF APPELLANTS

The rejection of claims 1-8, 10, 13-15 and 17-21 shall stand or fall with the patentability of claim 1.

The Rejection Of Claims 1-21 Under 35 U.S.C. 103(a) as Unpatentable Over Bennett 6,251,013 In View Of Schultz Asserts That:

- 1) Bennett shows randomly selecting a number of viewable symbols as a wild symbol position after a predetermined triggering event (column 1, lines 55-67 and column 2, lines 33-38).
- 2) Converting each selected symbol position to wild symbol , positions Figs. 4 and 5; column 2, lines 54-67).
- 3) It is asserted that Bennett is silent with respect to the recitation of a) selection between zero and fewer than the maximum number of symbol positions, and b) determining the outcome of the game based on game symbols and wild symbols “within the same game event.”
- 4) It is asserted that Schultz teaches all of the limitations a) and b) that are absent from Bennett, citing the disclosure of Schultz at column 3, lines 62-67 and column 7, lines 28-36 (and later citing column 7, lines 19-36).
- 5) It is asserted to be obvious to combine the features of Schultz into the game play of Bennett and therefore render the claimed subject matter obvious.

The first failure in the rejection is the fact that Schultz does not effectively teach the limitations for which it is cited, at least in a context that is translatable to the format of Bennett.

Schultz does not display a first set of symbols and then randomly select wild cards. Schultz selects a single wild card position in a set of five frames (a poker hand), the card in that position and every like or matching card becomes wild. There is no subsequent **random** assignment of wild card positions after a triggering event, as the remaining wild card positions are determined by the previous presence of the like card(s). Even though Schultz does show a wild card game, the format is incompatible with the method of play of Bennett.

Schultz also shows a card game in which the position of cards is not significant. There are five positions (in a five-card game), and the order of cards is not instrumental in play of the game. In poker, all that is important is the combination of cards in rank and/or suit. All claims in this application recite a reel-type slot machine, which is position dependent and multi-line dependent. In other words, multiple pays in a single game are typical. A method of play unique to poker video games (the method taught by Schultz) where positions are not significant to play of the game does not lend itself to one of ordinary skill in the art for use in multi-line reel-type slot games where symbol position is critical to payouts.

Claim 1 on Appeal recites, among other limitations:

“...upon the occurrence of a predetermined triggering event, randomly selecting between zero and fewer than a maximum number of viewable symbol positions as a wild symbol position;”

As noted, Schultz does not randomly select wild symbols after a triggering event. There is no bonus activating triggering event in Schultz. The play of each and every hand includes the selection of a wild card position, the identification of the card in that position as wild, and the conversion of any like cards to a wild card prior to scoring. This is incompatible with both the claimed invention (where a predetermined triggering event causes the random selection of at least one wild symbol **position**) and with Bennett.

Schultz cannot be combined with Bennett in any sense that is reasonably motivated by the teachings of the references. The combined teachings do not suggest altering the play of Bennett in any manner that would render the claimed invention of Applicant obvious. Claim 1 specifically recites:

“...determining game outcomes based on the displayed game symbols and wild symbols in a single game event.”

The claim requires the capability and activity of determined “game outcomes” (plural) which is essential in the play of reel-type slot video games. Schultz teaches only the conventional poker play resolution of determining if a **single** hand of sufficient rank has been obtained to award a prize. This is both 1) determination of a single outcome (not plural outcomes) that is 2) position independent as opposed to position critical, which latter limitation is present in both the present invention and in Bennett. It is not obvious nor is it prospectively beneficial to use a feature that is position independent as a basis for awards in a system that is position critical. The impact on payout events would have to be thoroughly re-evaluated in such a replacement, and the viability of the results would not have been prospectively understood. That fact undercuts any potential for asserting obviousness in the combination of the teachings of the two references.

As shown by the above arguments with respect to this limitation, there is a significant difference between the play recited in claim 1 and the process described by Bennett 013. The claims recite that:

“...upon the occurrence of a predetermined triggering event, randomly selecting between zero and fewer than a maximum number of viewable symbol positions as a wild symbol position;”

The combination of Bennett in view of Schultz does not teach this limitation.

The 013 patent is further distinguished from all claims in this Appeal (not only claim 1, except that the argument of a 'single event' does not apply to claim 12, which claim is separately distinguished). To show these further distinctions, as there are numerous different methods and alternatives described in the 013 Patent, each alternative method of Bennett 013 must be distinguished. The present claims will be compared to the individual examples (referred to by the Example and Number) given for alternatives in the 013 Patent.

In example 1 of Bennett, a certain symbol is designated as wild. The claims designate symbol positions within the display as a wild position, which can include any or all types of game symbols. When two or more wild positions are selected, the symbols in the selected wild positions may be different symbols or the same positions. At no time is a specific symbol selected to be wild. That limitation is already in the claim.

“...randomly selecting...viewable symbol positions”.

In example 2, a single symbol is selected and is given a “scatter” function. In this instance, it is again a symbol, rather than a symbol position, that is designated.

In example 3, two different symbols are selected and the positions are swapped prior to scoring. Once again, symbols are selected, symbols are swapped, and there are no symbol positions that are selected and designated as wild.

In a 4th example, a wheel with special symbols appears on the screen, and all symbols are designated “special”. Although the manner of scoring in this example is not clear, the random number generator is selecting a symbol, rather than a symbol position. It is clearly a general symbol that is selected, not a specific symbol position on the reel or screen.

In the 5th example, a row or column is randomly chosen, and all symbols appearing in that row or column are designated wild **IN ANOTHER GAME**. A win in the designated row or column enhances the payout in the next game. The present claims have been amended to recite that the selection of symbol positions enables game outcome

determination in the same game event, while this embodiment of Bennett requires that wild symbols be used in subsequent game play.

In contrast, the present claims randomly select symbol positions to designate as wild **IN THE SAME GAME**. The claims have been amended to recite the language “in a single game event” to clarify this position.

It is therefore clear that neither reference alone shows the limitations of the claims, that the references cannot be reasonably combined to place the limitations within a single game play framework, and that claim 1 is not obvious from the combined teachings of the references.

The rejection of claim 9 shall stand or fall alone. This claim defines a specific visual relationship between the symbol to which a position is converted and the appearance of the original symbol.

There is absolutely no teaching or semblance of a teaching of the limitations of this claim in the references. The claim requires that “at least one wild position is converted to a wild symbol with the same appearance as the wild symbols that triggered the bonus event.” Neither reference even has a wild symbol that triggers a bonus event. Bennett shows a fairy that flits from identical symbol to identical symbol and converts the symbol to a wild symbol. There was no original wild symbol to which conventional symbols are converted. Schultz determines a card position and then converts the card in that position and any matching cards to a wild card. There was no original triggering event, there also being no bonus event in Schultz.

Schultz determines the wild card by selecting a single card position. In contrast, the present invention selects zero or more positions, that has the effect of making it possible to designate more than one game symbol as wild. This is the specific deficiency in Bennett that cannot be overcome by the teachings of Schultz.

This rejection is clearly in error and must be reversed.

The rejection of claim 12 shall stand or fall by itself. This claim recites that game outcomes are determined based upon the predetermined combinations of displayed game symbols and wild symbols.

With regard to claim 12, a separate argument can be made. In the 013 reference, the selected line or column in the next game doesn't really act as a wild symbol. In scoring the game of example 5 (of Bennett 013), the player uses the normal game symbols. If a normal symbol combination appears anywhere in the designated line or row, the player gets an enhanced payout. The method of play does not increase the probability of getting more combinations, it just increases the possible payout. The claim, as revised, distinguishes over this art in the step of "determining game outcomes based on the predetermined combinations of displayed game symbols and wild symbols."

The addition of Schultz does not correct any of these differences. Schultz also selects a specific symbol and designates all equivalent symbols as wild in the play of that hand. Even if the play of the game of Schultz were combined with each of the disclosed games of Bennett 013, the game play recited in the present claims would not be taught.

At best, Schultz allows a single symbol position to be selected (which may be a random selection by the machine, see column 3, lines 62-68), then discloses the specific symbol that is present on that position, and then converts all equivalent symbols (not positions) to become wild symbols. Additionally, the selection of the one and only symbol position is the standard play of the Schultz game, not a triggered bonus event. The machine always selects only a single position as a wild position, and the potential for additional wild cards is not position based, but is symbol based.

Additionally, as the claim recites that the selection of the number of positions that are to be selected (e.g., from zero to less than all positions), the specific selection of one position in all cases is different from the broadest interpretation of the practice of Schultz.

Claims 16 shall stand or fall with the patentability of claim 16 which recites a specific alternative payout characteristic.

Claim 16 is at least patentable because it contains every limitation of claim 1, which has already been shown to be patentable over the combination of Bennett in view of Schultz. Neither reference shows the resolution of a payout on a first underlying game before the award of the bonus event. Schultz does not even show a bonus event.

BRIEF ON APPEAL

Serial Number: 09/ 645,025

Filing Date: September 1, 2000

Title: VIDEO GAMING SYSTEM WITH WILD CARD SYSTEM AND BONUS SYSTEM

Page 17 of 22

Docket No.: PA0463.ap.US

CONCLUSION

All rejections of record have been shown in detail to be in error. The rejection should be reversed and all claims should be indicated as allowable.


Applicants believe the claims are in condition for allowance and request reconsideration of the application and allowance of the claims. The Examiner is invited to telephone the below-signed attorney at 952-832-9090 to discuss any questions that may remain with respect to the present application.

Respectfully submitted,
Mark L. Yoseloff

By his Representatives,
MARK A. LITMAN & ASSOCIATES, P.A.
York Business Center, Suite 205
3209 West 76th Street
Edina, MN 55435
(952)832.9090

Date 11 June 2003

By



Mark A. Litman
Reg. No. 26,390

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to MAIL STOP AF, Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450 on June 11, 2003.

Name: Mark A. Litman



Signature

APPENDIX - THE CLAIMS ON APPEAL

1. A method of playing a video wagering game, comprising:

a player placing a wager on a reel-slot-type video game event having a plurality of symbol positions; displaying a plurality of randomly selected game symbols on a display, each symbol appearing in a designated symbol position;

upon the occurrence of a predetermined triggering event, randomly selecting between zero and fewer than a maximum number of viewable symbol positions as a wild symbol position;

converting each symbol displayed within each selected wild symbol position to a wild symbol; and

determining game outcomes based on the displayed game symbols and wild symbols in a single game event.

2. The method of claim 1, wherein the conversion of each symbol within each wild symbol position takes place one at a time.

3. The method of claim 1, wherein between one and one less than all available symbol positions are selected as wild symbol positions.

4. The method of claim 1, wherein each wild symbol is identical.

5. The method of claim 1, wherein each wild symbol morphs into a game symbol prior, after to or during the step of determining game outcomes.

6. The method of claim 1, wherein each wild symbol is wild as to all game symbols.

7. The method of claim 1 further comprising the step of awarding a prize for winning outcomes.

8. The method of claim 7, wherein the winning outcomes are awarded according to a look up table.

9. The method of claim 1, wherein the triggering event is the appearance of two wild symbols, and wherein at least one wild symbol position is converted to a wild symbol with the same appearance as the wild symbols that triggered the bonus event.

10. The method of claim 1, wherein the triggering symbol or combination of symbols comprises a symbol on both a first and fifth reel in a scatter arrangement.

12. A method of playing a video wagering game, comprising:
a player placing a wager on a reel-slot-type video game;
displaying a plurality of randomly selected game symbols on a display,
each symbol appearing in a designated symbol position;
upon the occurrence of a predetermined triggering event, randomly
selecting at least one, and fewer than all symbol positions as [a] wild symbol
positions;
converting each symbol displayed within each selected wild symbol
position to a wild symbol;

retaining wild symbols in their respective positions and randomly distributing at least some non-wild symbols into frames in the display to perform a second gaming event; and

determining game outcomes based on predetermined combinations of the displayed game symbols and wild symbols in the second gaming event.

13. An apparatus for playing a video wagering game comprising a housing, a memory system, and a monitor, the memory system directing a process comprising, not necessarily in sequence:

- a) accepting a wager on a reel-slot-type video game;
- b) displaying a plurality of randomly selected game symbols on a display, each symbol appearing in a designated symbol position;
- c) upon the occurrence of a predetermined triggering event, randomly selecting at least one but fewer than all symbol positions as wild symbol positions
- d) converting each symbol displayed within each selected wild symbol position to a wild symbol; and
- e) determining game outcomes based on the displayed game symbols and wild symbols within a single game event.

14. The apparatus of claim 13 wherein after step b) and before step d), a game using the randomly selected game symbols on a display is resolved.

15. A method of playing a video wagering game with a bonus feature, comprising:

- a player placing a wager on a reel-slot-type video game having a plurality of symbol positions;

displaying a plurality of randomly selected game symbols on a display, each symbol appearing in a designated symbol position;

addressing any winning events by a procedure selected from the group consisting of a) resolving any winning events, b) carrying any winning events forward for later resolving, and c) carrying any winning events forward for modification of the winning event by a bonus play;

upon the occurrence of a predetermined triggering event for a bonus event, randomly selecting at least one and fewer than all of said plurality of symbol positions as a wild symbol position;

converting each symbol displayed within each selected wild symbol position to a wild symbol; and

determining a bonus outcome based on the displayed game symbols and wild symbols within the gaming event.

16. The method of claim 15 wherein any winning event from displaying a plurality of randomly selected game symbols on a display are resolved before determining a bonus outcome based on the displayed game symbols and wild symbols.

17. The method of claim 15 wherein any winning event from displaying a plurality of randomly selected game symbols on a display are resolved after determining a bonus outcome based on the displayed game symbols and wild symbols.

18. The method of claim 15 wherein any winning event from displaying a plurality of randomly selected game symbols on a display are resolved at about the same time as determining a bonus outcome based on the displayed game symbols and wild symbols.

19. The method of claim 1, wherein the maximum number of viewable positions is 15.
20. The method of claim 1, wherein an appearance of the wild symbol changes to another game symbol at or before game outcomes are determined.
21. The method of claim 1, wherein the wild symbols are wild as to fewer than all of the game symbols.

CLAIM OBJECTED TO AS NOT BEING IN INDEPENDENT FORM, BUT NOT REJECTED

11. The method of claim 1, wherein symbol positions bearing game symbols that produce scatter pays are excluded from the random selection of wild symbol positions.